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10/520,669

02/04/2005

Peter Janssen

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10/23/2006

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EXAMINER

YOUNG, EDWIN

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/520,669 | Applicant(s) JANSSEN, PETER | |
| | Examiner Edwin A. Young | Art Unit 3681 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/06/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first action on the merits for application 10/520,669. Claims 5-8 are pending in this application.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP03/07571, filed on 7/14/2003.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 1/06/2005 has been considered by the examiner.

Specification

4. The abstract of the disclosure is objected to because "Fig. 1" should be deleted. Correction is required. See MPEP § 608.01(b).
5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in PCT Rule 5, the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

The headings of the parts of the description should be as follows:

- (i) for matter referred to in Rule 5.1(a)(i), "Technical Field";
- (ii) for matter referred to in Rule 5.1(a)(ii), "Background Art";
- (iii) for matter referred to in Rule 5.1(a)(iii), "Disclosure of Invention";
- (iv) for matter referred to in Rule 5.1(a)(iv), "Brief Description of Drawings";
- (v) for matter referred to in Rule 5.1(a)(v), "Best Mode for Carrying Out the Invention," or,
where appropriate, "Mode(s) for Carrying Out the Invention";

- (vi) for matter referred to in Rule 5.1(a)(vi), "Industrial Applicability";
- (vii) for matter referred to in Rule 5.2(a), "Sequence Listing";
- (viii) for matter referred to in Rule 5.2(b), "Sequence Listing Free Text."

6. The disclosure is objected to because of the following informalities:

- Page 1, paragraph 1, "according to the preamble of Claim 1" should be deleted and the desired elements should be written in their entirety. In its final form the claims may be renumbered (as they have already been done by the preliminary amendment) and therefore the meaning of the reference to claim 1 is altered.
- Page 1, paragraph 2, "behaviour" should be changed to --behavior--.
- Page 1, paragraph 2, "converter automatic transmission" should be changed to --torque converter of an automatic transmission--.
- Page 1, paragraph 3, "behaviour" should be changed to --behavior--.
- Page 1, paragraph 5, "according to the preamble of Claim 1" should be deleted and the desired elements should be written in their entirety, for reasons discussed above.
- Page 1, paragraph 5, "behaviour" should be changed to --behavior--.
- Page 1, paragraph 6, "characterizing clause of Claim 1" should be deleted and the desired elements should be written in their entirety, for reasons discussed above.
- Page 2, paragraph 2, "Figs 1 and 2" is in an unacceptable format. Separate descriptions should be given for each figure.
- Page 2, paragraph 3, "These" should be replaced with --Figs 1 and 2--.

Appropriate correction is required.

Claim Objections

7. Claim 8 is objected to because of the following informalities: Line 1, "The method" should be changed to --A method--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are in improper method form in that they do not particularly point out each of the active, positive method steps carried out using the gerund form of the verb e.g. *slipping* the clutch.

Regarding claims 5, 7 and 8, the term "function clutch" is not an accepted term and it is unclear from the disclosure as to the meaning of this term.

Regarding claims 5 and 8, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 5 recites the limitation "the starting operation" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. The limitation "the starting operation" should be changed to --a starting operation--.

Claim 5 recites the limitation "the starting" in line 5. There is insufficient antecedent basis for this limitation in the claim. The limitation "the starting" should be changed to either --a starting-- or --the starting operation--.

The term "short" in claim 5 is a relative term which renders the claim indefinite. The term "short" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to a precise quantity or range for the "predetermined period of time" characterized as being "short" in claim 5.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "a time of between about 100 and about 1000 ms", and the claim also

Art Unit: 3681

recites "in particular of between about 100 and about 250 ms" which is the narrower statement of the range/limitation.

Claim 7 recites the limitation "the turbocharger" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the starting operation" in line 5. There is insufficient antecedent basis for this limitation in the claim. The limitation "the starting operation" should be changed to --a starting operation--.

Claim 8 recites the phrase "a function clutch" in lines 5-6. This appears to be a double inclusion of the phrase "a function clutch" in line 2 and therefore "a function clutch" in lines 5-6 should be changed to --the function clutch--.

Claim 8 recites the limitation "the respective dynamic operating point" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim. The limitation "the respective dynamic operating point" should be changed to --a respective dynamic operating point--.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHIELE (WO 01/86176 A1).

SCHIELE discloses a method for operating an automatic transmission, having a torque converter and a function clutch, of a motor vehicle having an internal combustion engine and turbocharger with a rising torque characteristic in the lower rotational speed range, in which a starting operation is carried out via the torque converter, characterized in that, during a starting of the motor vehicle, the function clutch used in this case is initially induced to slip during a short predetermined period of time until a starting torque has built up and the function clutch is controlled in such a way that the converter characteristic is thereby adapted to a respective dynamic operating point (as described in the English language abstract and the English language equivalent patent US 6,785,598 B2).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCHIELE (WO 01/86176 A1).

Regarding claim 6, SCHIELE discloses the method according to claim 5, as discussed above, but does not expressly state that the predetermined period of time for slip is set between about 100 and 1000 ms. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to slip the function clutch for a predetermined period of time between 100 and 1000 ms, since it has been

Art Unit: 3681

held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- TABATA (US 2002/0006848 A1) discloses an apparatus for controlling vehicle drive system including engine with turbocharger, and lock-up clutch (see Abstract).
- SCHIELE (US 6,785,598) is the English language equivalent of SCHIELE (WO 01/86176 A1) described above.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. Young whose telephone number is 571-272-4781. The examiner can normally be reached on M-TH 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
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